

REMARKS

The Office Action dated January 23, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 3-5, 7-29, 37-39, 41-48, and 50-69 are currently pending in the application, of which claims 1, 29, 37-39, 46, 48, 50, 63, 66, and 69 are independent claims. Claims 1, 29, 37, 39, and 41-48 have been amended, and claims 50-69 have been added, to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 31-36 have been cancelled without prejudice or disclaimer. Claims 1, 3-5, 7-29, 31-39, 41-48, and 50-69 are respectfully submitted for consideration.

Claims 1, 3-8, 14, 16-17, 20, 24-29, 36-39, 42, and 44-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP TS 24.229 version 5.3.0 Release 5 (“the 229 reference”) in view of 3GPP 23.218 version 5.3.0 Release 5 (“the 218 reference”). (As noted in the previous response filed November 14, 2007, the rejection of claim 6 is moot and should be withdrawn, because claim 6 was cancelled without prejudice or disclaimer.) The Office Action took the position that the 229 reference discloses some of the features of the claims, but cited the 218 reference to remedy certain deficiencies of the 229 reference with respect, for example, to “the originating request includes information regarding the handling of communications associating with the request.” (Office Action, page 3). Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the cited art.

Claim 1, upon which claims 3-5 and 7-28 depend, is directed to a service provisioning method including receiving, at a first entity associated with a communication system from a storage entity, information comprising an address of or a name of a communication control entity configured to service a user of the communication system. The method also includes generating, by the first entity, an initial request on behalf of the user. The method further includes based on the information, signaling the initial request from the first entity to the communication control entity. The initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

Claim 29 is directed to a communication system including a communication control entity configured to service a user of a communication system. The system also includes a first entity provided with a first interface configured to receive information from a storage entity comprising an address of or a name of the communication control entity and a second interface configured to signal an initial request to the communication control entity based on the information from the storage entity. The first entity is configured to generate the initial request on behalf of the user. The initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

Claim 37 is directed to an application server including a first interface configured to receive information from a storage entity regarding a user of the communication

system. The application server also includes a second interface configured to signal an initial request to a communication control entity configured to service the user based on the information from the storage entity, the information comprising an address of or a name of the communication control entity. The initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

Claim 38 is directed to an initial request to be signaled on an interface between a first entity of a communication system and a communication control entity configured to service a user of the communication system, the initial request being generated based on information from a user information storage entity. The information comprises an address of or a name of the communication control entity. The initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

Claim 39 is directed to a network entity including receiving means for receiving at a first entity associated with the communication system from a storage entity, information comprising a name of or an address of a communication control entity configured to service a user of the communication system. The network entity also includes signaling means for signaling an initial request from the first entity to the communication control entity based on the information. The network entity is configured to generate the initial request on behalf of the user. The initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

Claim 46, upon which claims 41-45 and 47 depend, is directed to a network entity including a first interface configured to receive information from a storage entity comprising an address of or a name of a communication control entity configured to service the user based on the information from the storage entity. The network entity also includes a second interface configured to signal an initial request to the communication control entity. The network entity is configured to generate the initial request on behalf of the user. The initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

Claim 48 is directed to a storage entity including two stored addresses of a communication control entity. The storage entity also includes an address for an originating role. The storage entity further includes an address for a terminating role. The storage entity is configured to send one or both of the two stored addresses to an application server on request for use in generating an initial request on behalf of a user. The initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

Applicants respectfully submit that the combination of the 229 reference and the 218 reference fails to disclose or suggest all of the elements of any of the presently pending claims.

The Office Action acknowledged that the 229 reference fails to disclose or suggest that the initial (formerly presented as “originating”) request includes information

regarding handling the of communications associating with the request. Thus, it should be clear that the 229 reference fails to disclose or suggest, “wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service,” as presently recited in, for example, claim 1.

The Office Action cited the 218 reference to remedy this deficiency of the 229 reference. Although the rejection was made “final” the ground of rejection appears to have changed. Specifically, the previous Office Action (mailed August 14, 2007) alleged that the formerly presented feature of claim 1 was disclosed by the 218 reference at Section 5.2, pages 12-13, and Section 6.3, pages 15-16. Applicants respectfully submit that the 218 cannot remedy the deficiencies of the 229 reference, when the claims are considered as a whole.

Specifically the previously cited portions of the 218 reference address a method in which the initial request is from the user rather than from the application server, which is similar to the material discussed in the background section of the present application. The presently pending claims, in contrast, are concerned with sending an initial request from another entity than the user equipment (such as from an application server) to a control entity on behalf of a user, the initial request from the application server including information regarding whether to originate or terminate a service.

Accordingly, it is respectfully submitted that the previously cited portions of the 218 cannot reasonably correspond to a disclosure regarding the content of a request generated as recited in the claims.

Further distinctions and/or indicia of non-obviousness may also be seen from a careful review of the references.

For example, the 218 reference only discloses applying originating and terminating filter criteria to mobile originated or mobile terminated requests, *i.e.* when the initial request comes from the user equipment. Furthermore, section 6.3 of the 218 reference is also only concerned with the situation where an initial request comes from the user equipment. As such, the teachings of the 218 reference are consistent with the background section of the present application in that all that is explained is to provide originating and terminating filter criteria based on an initial request from a mobile user.

Furthermore, it was mentioned in section 5.7.3 the 229 reference that an application server may act on behalf of a user in sending an initial request. However, what the present applicants have realized and explained in the present application is that when attempting to implement the teachings in the cited documents a problem occurs in that the communication control entity serving the user conventionally assumes that requests coming from an application server are for terminating services rather than originating services.

Based on such an assumption, the control entities in the conventional systems treat such signals on behalf of user equipment in this manner. Accordingly, the present applicants have discovered that the communication control entity needs to be prevented from applying such an assumption, and have provided a solution by specifically indicating to the initial control entity information regarding the handling of communications associated with the request from the application server indicating

whether to originate or terminate a service. This feature is recited in claim 1 as “wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.”

In short, the control entity needs to be configured to extract such information, process it, and act upon it in the appropriate manner. This problem and its associated solution are neither disclosed nor suggested in the cited references and any suggestion to the contrary would constitute an improper hindsight analysis of the cited documents in light of the teachings of the present application. Logically following the teachings of the cited documents using the knowledge of one of ordinary skill in the art without any knowledge of the present application's invention does not, could not, and would not lead to the present invention. Thus, it is respectfully submitted that the claims are non-obvious over the cited art, and it is respectfully requested that the rejection be withdrawn.

In the present Office Action, a new ground of rejection has been attempted, this time based on citation to Section 6.4 of the 218 reference, in which, according to the Office Action, “the S-CSCF checks trigger points to determine if it is an originating request or a terminating request.”

In order to understand why this does not correspond to what is claimed, it is important to note the overall change in the way that the cited art is being applied by the Office Action to the claims.

In the previous office action, the Office Action had equated the Home Subscriber Server (HSS) in the cited prior art as being equivalent to the presently claimed storage

entity, the Serving Call State Control Function (S-CSCF) as being equivalent to the presently claimed communication control entity, and the application server in the cited art as being equivalent to the first entity of the present claims. In light of the previous response to the previous office action, the current Office Action appears to have altered the analysis whereby the Office Action is now equating the **S-CSCF** in the cited art as being equivalent to the first entity of the presently claimed invention and is equating the **application server** in the cited prior art as being equivalent to the communication control entity of the present claims. This analysis is set out on pages 2 and 3 of the Office Action. Furthermore, on pages 15 and 16 of the Office Action, the Office Action (apparently inconsistently with the analysis at pages 2-3) indicated that the first entity of the presently claimed invention could be a user equipment.

The claims have been amended, and – in view of the amendments to the claims – it is clear that the first entity is or comprises an application server. Thus, the Office Action’s new analysis in which the first entity as claimed corresponds to a S-CSCF or a user equipment in the cited art, cannot be maintained. As stated on page 4 of the present application’s specification, certain embodiments of the present invention are directed to the problem of an application server initiating processes requiring communications on behalf of the user such that the user could be seen as the originating party. Neither of the cited art documents disclose or suggest the receiving and generating features of the presently claimed invention in an application server and signaling the generated initial request indicating whether to originate or terminate a service from the application server to a communication control entity, such as an S-CSCF.

It should be noted that claim 25, as previously presented, specified that the first entity comprises an application server. The Office Action stated in item 13 of the present office action that the 229 reference shows the first entity comprising an application server in section 5.7.3. Accordingly, on the one hand the Office Action has stated that the first entity is the S-CSCF in the cited documents whereas on the other hand he has stated that the application server is the first entity. This is clearly contradictory.

Furthermore, if the Office Action were to change the analysis set out in the present office action such that the application server in the cited document is equated with the first entity then the original arguments set forth above previously presented in response to the previous office action would be applicable. In particular, the present applicants have realized that when attempting to implement the teachings of the cited documents a problem occurs in that the S-CSCF in the prior communication systems assumes that requests coming from an application server are for terminating services rather than originating services. As such, the S-CSCF treats such signals in this manner. Accordingly, the present applicants have found that the S-CSCF can be prevented from doing this by specifically indicating to the S-CSCF in an initial request from the application server information indicating whether to originate or terminate a service. The S-CSCF can then use this information in order to act in an appropriate manner.

Thus, for all the reasons set forth above, it is respectfully requested that the rejection of claim 1 be withdrawn.

The rejection has been discussed above primarily with respect to independent claim 1. Independent claims 29, 37-39, 46, and 48 each have their own scope, but each

recite features such as those discussed above with respect to claim 1. Thus, it is respectfully requested that the rejection of each of claims 1, 29, 37-39, 46, and 48 be withdrawn.

Claims 3-5, 7-8, 14, 16-17, 20, 24-28, 42, 44-45, and 47 depend respectively from, and further limit, claims 1, 29, 39, and 46. Thus, each of claims 3-5, 7-8, 14, 16-17, 20, 24-28, 42, 44-45, and 47 recites subject matter that is neither disclosed nor suggested in the cited art. Claims 6 and 36 have been cancelled without prejudice or disclaimer. It is, therefore, respectfully requested that the rejection of all of claims 3-8, 14, 16-17, 20, 24-28, 36, 42, 44-45, and 47 be withdrawn.

The remaining presently pending claims were also rejected based on the combination of references discussed above, together with additional cited references. Claims 9-10, 13, 21-23, 31-32, 35, 41, and 44 were rejected under 35 U.S.C. 103(a) as being unpatentable over the 229 reference in view of the 218 reference and further in view of WO 02/09365 of Kauppinen et al. (“Kauppinen”). Claims 11-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over the 229 reference in view of the 218 reference and Kauppinen and further in view of U.S. Patent Application Publication No. 2003/0053441 of Banerjee (“Banerjee”). Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over the 229 reference in view of the 218 reference and further in view of U.S. Patent Application Publication No. 2002/0027915 of Foti et al. (“Foti”). Claims 18 and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over the 229 reference in view of the 218 reference and further in view of RFC 2782. Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over the 229 reference in view

of the 218 reference and further in view of RFC 2168. Claims 33-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over the 229 reference in view of the 218 reference and further in view of U.S. Patent Application Publication No. 2001/0049790 of Faccin et al. (“Faccin”). Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in any of the combinations of cited references.

Claims 9-13, 15, 18-19, 21-23, 41, and 43-44 depend respectively from, and further limit, claims 1, 29, and 39. Thus, each of claims 9-13, 15, 18-19, 21-23, 41, and 43-44 recites subject matter that is neither disclosed nor suggested in the cited art discussed above. The additional references cited for the further limitations of the claims unsurprisingly do not remedy the above-identified deficiencies of the 229 reference and the 218 reference (whether alone or in combination). Claims 31-35 have been cancelled without prejudice or disclaimer. It is, therefore, respectfully requested that the rejection of all of claims 9-13, 15, 18-19, 21-23, 31-35, 41, and 43-44 be withdrawn.

For the reasons set forth above, it is respectfully submitted that each of claims 1, 3-5, 7-29, 37-39, and 41-69 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1, 3-5, 7-29, and 41-69 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants’ undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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Enclosures: Additional Claims Transmittal
RCE Transmittal
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